<u>REMARKS</u>

<u>Rejection under 35 USC §103</u>

Claims 1-20 are rejected under 35 U.S.C. §103 as being unpatentable over *Tushie et al.* (U.S. Pat. No. 6,014,748) in view of *Du.* (U.S Pub. No. 2001/0042212), and further in view of *Anderson et al.* (U.S. Pat. No. 5,884,289).

<u>Smart Card Features not Disclosed</u>

Claims 1 and 11 require "default values for smart card features" and that "a smart card feature being a parameter representing a business requirement of said smart card issuer dictating smart card usage." As explained in the previous Reply, a "smart card feature" is a business or risk management requirement of the smart card issuer, such as whether or not to require a signature when a smart card is used. The Office action cites columns 2 and 18 (specifically, the "card framework template record") as disclosing the smart card features. Applicant respectfully disagrees.

The action at the top of page 4 points out that entries such as the account name and account number correspond to the default values for smart card features. But, an account name and an account number are simply static data specific to a particular cardholder. These values do not reflect a business requirement of the smart card issuer dictating how the smart card must be used, such as whether or not a signature is required. In addition, the last two steps of claim 1 require that the value for a smart card feature is used to personalize a batch of smart cards. In other words, the smart card feature (such as whether or not a signature is required) is applied to the entire batch of smart cards; each smart card would not have a different value for a particular feature. By contrast, data such as account name and account number must be different for each and every smart card. Therefore, data entries such as account name or similar cannot correspond to the default values for smart card features as claimed.

As explained in column 2, lines 54-59 (cited by the Office), the whole point of the cited issuer format template is to allow the personalization system to interface with multiple card issuer systems to make sure the personalization data is formatted correctly. By contrast, the invention of claims 1 and 11 is not trying to interface with different issuer systems; its smart card features are elicited from the user and applied to batch of smart cards. The data format template

cannot possibly disclose "smart card features and their values" because the data format template simply tells the system how to use individual cardholder data (see, for example, column 17, lines 26-31), while a smart card feature is a high-level issuer business requirement.

The action also cites the "card framework template record" as disclosing smart card features and their values. But, this template merely "describes the structure of the chip on the card" (column 18, lines 5-6). For example, Figure 11 shows the card framework template. It includes technical information such as system definitions, templates for embossing or for the magnetic stripe, application data, etc. Such information cannot possibly disclose a smart card feature which is a high-level issuer business requirement.

## Receiving Smart Card Feature Information not Disclosed

The second and third steps of claim 1 also require that the user is queried regarding the smart card features, and that the user provides responses reflecting smart card features desired by the card issuer. The Office action cites *Tushie* as disclosing receiving the smart card feature responses, and cites column 6, 7 and Figure 1B. But, the cardholder data 152 is standard personalization data unique to each cardholder and is not smart card features and their values as previously explained. Also as previously explained, this personalization data comes from the card issuer unchanged. There is no opportunity for a user to respond to queries and provide responses indicating values for particular smart card features.

## Not Obvious to Combine Because *Du* is Non-analogous Art

It would not have been obvious to combine *Du* with *Tushie* because the art is entirely different. *Tushie* deals with trying to make personalization data suitable for any type of smart card personalization equipment, while *Du* deals with creating a portable computing environment. One of skill in the art trying to personalizing a smart card would not concern themselves with how to make it easier for a business executive to carry their computing environment with them (as disclosed in *Du*).

To be more specific, *Tushie* deals with the personalization of batches of smart cards by a bank using personalization equipment before the smart cards are ever issued to users (Figure 1A). It is a light manufacturing process that involves feeding thousands of blank smart cards into sophisticated personalization equipment where they are stamped, embossed, programmed,

etc. *Tushie* deals primarily with how to personalize these batches using a variety of types of personalization equipment.

By contrast, *Du* deals with how a computer user might replicate their office computing environment on a computer in a remote office. The user possesses a smart card, but the card has long since been manufactured, personalized and issued by the bank to the user. The user is able to transfer a representation of their computing environment onto the smart card and then insert the smart card into a remote computer to help transfer that computing environment. The result is that the user is able to use their familiar browser, bookmarks, word processing templates, etc. The only thing in common that the two references have is use of the term "smart card." An analogy might be if one reference dealt primarily with programming the firmware of thousands of laptop computers in a factory, and a second reference dealt with how a single user might use a single laptop to read e-mail. The two references would not be analogous.

For these reasons, one of skill in the art of personalizing smart cards (such as *Tushie*) would not be motivated to inquire into the field of "how can I move my bookmarks from one computer to another?" (such as *Du* discloses), and would be unaware of the art in that field. Therefore, one of skill would not be motivated to combine the two references.

## *Du* Does not Disclose Smart Card Features

The Office action on page 4 cites *Du* as disclosing "providing a user with a plurality of queries regarding smart card features." But, *Du* cannot possibly disclose queries regarding smart card features because *Du* discloses queries related to configuring the user's personal computing environment (paragraph 48). An issuer business requirement regarding how a batch of smart cards must be used is entirely different from a question to a computer user regarding his or her favorite Web site.

Reconsideration of this application and issuance of a Notice of Allowance at an early date are respectfully requested. If the Examiner believes a telephone conference would in any way expedite prosecution, please do not hesitate to telephone the undersigned at (612) 252-3335.

Respectfully submitted,

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